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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,807	04/27/2001	Kraig A. Kirschner	261/178	4280

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EXAMINER

BRITTAIN, JAMES R

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,807

Applicant(s)

KIRSCHNER, KRAIG A.

Examiner

James R. Brittain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Steinke (US 4408928).

Steinke (figures 2-5) teaches connector structure for attachment to a beam 32, 33 having first legs 36 and second legs 34 that define a cord space therebetween. The connector comprises an anchor plate 41, 44 extendable across the cord space into juxtaposition with the second legs, an engagement plate 50 including a flat anchor portion 51 and upstanding engagement portions to either side of the flat anchor portion, each upstanding engagement portion having a distal edge with an engagement profile defining an intermediate tongue 56 flanked on each side by shoulders 57 that abut the first legs 36 for interlocking engagement and a threaded stud in the form of the bolt 48 that passes through apertures in the anchor and engagement plates. The attachment hardware and beam are not claimed in combination and the device of Steiner is inherently fully capable of performing as a seismic adapter to secure attachment hardware to a beam.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinke (US 4408928) in view of Koyama (US 5259165).

Steinke (figures 2-5) teaches connector structure for attachment to a beam 32, 33 having first legs 36 and second legs 34 that define a cord space therebetween. The connector comprises an anchor plate 41, 44 extendable across the cord space into juxtaposition with the second legs, an engagement plate 50 including a flat anchor portion 51 and upstanding engagement portions to either side of the flat anchor portion, each upstanding engagement portion having a distal edge with an engagement profile defining an intermediate tongue 56 flanked on each side by shoulders 57 that abut the first legs 36 for interlocking engagement and a threaded stud in the form of the bolt 48 that passes through apertures in the anchor and engagement plates. The attachment hardware and beam are not claimed in combination and the device of Steiner is inherently fully capable of performing as a seismic adapter to secure attachment hardware to a beam. The difference is that the anchor plate is not threaded and it isn't square. However, Koyama (figures 3-5) teaches forming an engagement plate 2 with a tongue 2e flanked by two shoulders and an anchor plate 3 that is flat over the length of the second legs of the beam and is with a threaded aperture 3g to receive the threaded stud. It would have been obvious to modify the connector structure of Steinke so that

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the anchor plate has a threaded aperture to receive the bolt in view of Koyama suggesting such structure and to render the anchor plate flat and square is a matter suggested by the structure of Koyama in which the engagement face of the anchor plate 3 with the second legs of the beams is flat and while using a trapezoidal geometry, the use of a square geometry would appear to be obvious since there does not appear to be a beneficial result over that taught by Koyama. As to claims 5 and 6, the tongue 2e of Koyama has the free end curved so as to aid in insertion and this suggests tapering the tongue of the connector of Steinke. Further with respect to claim 6, Steinke shows the engagement portion to extend at a right angle to the flat anchor portion and to change the angle so as to be at an obtuse angle would have been obvious since the device of Steinke would function equally well.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steinke (US 4408928).

Steinke (figures 2-5) teaches connector structure for attachment to a beam 32, 33 having first legs 36 and second legs 34 that define a cord space therebetween. The connector comprises an anchor plate 41, 44 extendable across the cord space into juxtaposition with the second legs, an engagement plate 50 including a flat anchor portion 51 and upstanding engagement portions to either side of the flat anchor portion, each upstanding engagement portion having a distal edge with an engagement profile defining an intermediate tongue 56 flanked on each side by shoulders 57 that abut the first legs 36 for interlocking engagement and a threaded stud in the form of the bolt 48 that passes through apertures in the anchor and engagement plates. The attachment

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hardware and beam are not claimed in combination and the device of Steiner is inherently fully capable of performing as a seismic adapter to secure attachment hardware to a beam. The difference is that the engagement portion extends at a right angle to the flat anchor portion. It would have been obvious to extend the angle so as to be obtuse since there is no improvement in function or critical reason to be at an obtuse angle.

Response to Arguments

Applicant's arguments filed November 18, 2002 have been fully considered but they are not persuasive. Applicant's arguments assert that claim 1 as amended is not anticipated by Steinke because it does not disclose that the stud extends beyond the engagement plate so that attachment hardware may be suspended from the stud and that to the extent that the stud disclosed in Steinke extends beyond the engagement plate, it is to secure the engagement plate and the anchoring plate to the beam (Remarks, Page 4, last line - Page 5, line 5). What applicant is characterizing as a difference is a statement of intended use, while structurally applicant recognizes that the stud does extend beyond the engagement plate as claimed. Review of the claim shows that the "seismic adapter" is "for suspending attachment hardware from a steel web joist including a beam" (lines 1-2, underlining added), the anchor plate is "extendable across the cord space" (line 5, underlining added), the engagement plate has is "with an engagement profile for interlocking engagement with the first legs" (lines 9-10, underlining added), and the stud is "extendable from the first hole to and beyond the second hole, with the anchor plate and the engagement plate positioned on the beam of

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the steel web joist, to suspend the attachment hardware therefrom and secure the anchor plate and the engagement plate to the steel web joist" (lines 11-14, underlining added). Each limitation is a statement of intended use as shown by "for", "extendable", and "to suspend". The attachment hardware and beam are not claimed in combination and the device of Steiner is inherently fully capable of performing as a seismic adapter to secure attachment hardware to a beam. In response to applicant's argument that the stud of the device of Steiner does not extend beyond the engagement plate so that attachment hardware may be suspended from the stud, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant argues that each of the other claims is allowable because of the argument applicant provides for claim 1 and since this argument is unpersuasive, the remaining claims stand rejected.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on Monday - Friday from 5:30 to 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

A handwritten signature in black ink, appearing to read 'J. R. Brittain', with a stylized flourish at the end.

James R. Brittain
Primary Examiner
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JRB
February 3, 2003